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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/040,008	01/04/2002	Masanobu Matsuo	49964.00002	8815
7590	04/06/2006			EXAMINER
David B. Abel, Esq. Squire, Sanders & Dempsey L.L.P. 14th Floor 801 S. Figueroa Street Los Angeles, CA 90017-5554			DANIELS MENDEZ, PHYLLIS A	
			ART UNIT	PAPER NUMBER
			3629	
DATE MAILED: 04/06/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/040,008	MATSUO, MASANOBU
	Examiner Phyllis A. Daniels-Mendez	Art Unit 3629

**– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –**  
**Period for Reply**

**A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.**

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### **Status**

- 1) Responsive to communication(s) filed on 04 January 2002.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### **Disposition of Claims**

- 4) Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-20 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### **Application Papers**

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 04 January 2002 is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### **Priority under 35 U.S.C. § 119**

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### **Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                     | Paper No(s)/Mail Date. _____ .  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|  | 6) <input type="checkbox"/> Other: _____ .                                  |

## DETAILED ACTION

### ***Specification***

1. The disclosure is objected to because of the following informalities: Located on page 2, Line 16 it currently reads "about the subject relating t:". Should be changed to "about the subject relating to:".

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

3. **Claims 1,3, 4-10 and 12-20 are rejected under 35 U.S.C. 102(a) as being anticipated by Gainey et al.(US 2002/0099681).**

**Gainey discloses the following:**

**Claims 1a/10a/20a:** Keep thread ownership--Specifies if the same user that responds to a particular incoming email message should receive all subsequent responses [0066, Line 1-4].

**Claims 1b/10b/20b:** Placing an identifier in the subject or body field of the outgoing response email enables the mail receiver to identify any reply to the outgoing response email [0066, Lines 4-7].

**Claims 1c/10c/20c:** During the mail receiver rule set processing, the incoming email receiver 120 may assign one or more categories to an email message [0053, Lines 1-3].

**Claims 1d/10d/20d:** In one embodiment, the actions required to stop a message timer for a message within a user mailbox can include generating a response to the message, marking the message as requiring no response, releasing the message back to the mail queue from which it came, or routing the message to a different mail queue [0095, Lines 4-9].

**Claims 3/12:** The return address on the email message forwarded to the outside person is an enterprise email system address so that a response created by the non-enterprise email responder will be received and tracked by the enterprise email system [Table on Page 5, Forward and Track, Lines 11-14]. This proves that the ability of a third party to transmit a request via the network utilizing a wireless device is old and well known in the wireless and technology arts.

**Claims 4/13:** Referring to FIG. 1, the enterprise mail system receives incoming email from the Internet 101 into an incoming email server 110 [0021, Lines 4-5].

**Claims 5/14:** Each standard phrase consists of a string that may include fields from the email database 130 such as <recipient> that designates the recipient's name [0112, Lines 4-7].

Art Unit: 3629

**Claims 6/15/20:** Each mail queue has a different mail queue timeout value that specifies the maximum amount of time that message may sit idle within a mail queue [0005, Lines 4-7]. The term "value" located in the previous sentence is used as the identifier.

**Claims 7/16:** The enterprise mail system users are listed in the mail user database 137.

The following list defines a set of parameters that define an enterprise mail system user account [Table located on Page 8]:

User Account Parameter	Parameter use
Name	The user's full name.
Password	The password used to access the user account.
Description	The title of the user such as "Customer Service Representative" or "Sales Person".
Admin Function level	A standard operator level allows the user to perform functions to respond to messages. An administrative level allows the user to configure parameters that control the enterprise email system.
Vacation Mode	Specifies if the user is on vacation, and if so which queue or mailbox should be used to handle this user's email if the user is on vacation.
Queues	Defines a set of queues that the user is assigned to.

**Claims 8/17:** FIG. 2B illustrates a screen display of a graphical user interface for entering a category into the category database 135 [0067, Lines 3-5].

**Claims 9/18:** The enterprise email user uses the listed actions for processing messages [0105, Lines 2-4].

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:
  - (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.
5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).
6. **Claims 2 and 11** are rejected under 35 U.S.C. 103(a) as being unpatentable over Gainey et al. in view of **Simson Garfinkel**, The Undefeated Airwaves, Technology Review v104n7, Sept 2001, pages 22-23.

Gainey fails to disclose the method of a third party transmitting a request via the network utilizing a wireless device. Garfinkel teaches the following:

...and that scarce resources are better spent on other goals. This spells real danger as wireless devices become a greater part of our economy. All of the large-scale wireless paging and data networks deployed in the 1980s and '90s repeated the cell - phone industry's mistake and eschewed encryption. Today these networks are the basis for popular wireless products like pagers and the Palm VII personal digital assistant . Messages sent using these systems can be-and are-intercepted with ease. What's worse, it can be nearly impossible for a consumer to make an informed decision about a product's security. Consider the Palm: all PalmOS. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included the use of a wireless device being used by a third party, as disclosed by Garfinkel.

### ***Conclusion***

7. Additional Literature has been referenced on the attached PTO-892 form, and the Examiner suggests the applicant review these documents before submitting any amendments.
8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Phyllis Daniels Mendez whose telephone number is (571) 272-7657. The examiner can normally be reached on Monday through Thursday, 8am - 5:00pm.
9. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone

Art Unit: 3629

numbers for the organization where this application or proceeding is assigned  
(571) 273-8300 for all official communications.

10. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Office of Initial Patent Examination whose telephone number is (703) 308-1202.

*pdm*  
pdm  
March 24, 2006

*JGW*  
JOHN G. WEISS  
SUPERVISORY PATENT EXAMINER  
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